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EXAMINER

CHOW, MING

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,088

Applicant(s)

INON ET AL.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The phrase “converted telephone number form of said telephone number” on Line 22 critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The phrase “converted telephone number form of said telephone number” is different from what the specification disclosed on Line 22 Page 3. See Examiner’s Interpretation below.

2. Claims 2, 3, 7, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “application unit” is confusing as if it refers to the “first application” or the “second application”.

3. Claims 2–5, 17 recite the limitation "persistence storage unit" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

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4. Regarding claim 8, the term "other" (line 17 page 13) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "other"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

5. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "first identifying information is a pronunciation of the new contact's name" in claim 30, does not reasonably provide enablement for "first identifying information is a telephone number of the new contact" in claim 32. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to enable the invention commensurate in scope with these claims. The claims 30 and 32 both depend on the claim 29 however with contradicting limitations. See Examiner's Interpretation below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 7, 9, 12, 13, 15, 17, 19-21, 23-33, 35-38, and 40-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer et al (US-PAT-NO: 6,381,324).

For claims 1, 9, 29, and 36, regarding a first application unit to host a telephone network-based system, Shaffer et al teach on item 213 Fig. 2 call processing center. The call processing center of Shaffer et al is the claimed telephone network-based system. It is inherent that there must be an application (the claimed first application) to host the telephone network-based system.

Regarding a second application unit programmed to present the user with contact data obtained via the electronic network, thereby assisting the user in selecting at least a portion of said contact data for entry into the personal address book, Shaffer et al teach on item 202 Fig. 2 calling location A. It is inherent that there must be an application (the claimed second application) to present the user (by computer or FAX or telephone of item 202) with contact information.

Regarding a voice response unit to route a user-initiated call into said system, to said second application unit, Shaffer et al teach on item 214 Fig. 2 VRU. Regarding a recognition server comprising an automatic speech recognizer for conversion to text form of a verbalized form of at least one new contact name forming part of said user-initiated call, Shaffer et al teach on Column 55 Line 46 capturing the first party identifier comprises capturing information from a voice

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recognition unit. Shaffer et al also teach on Column 21 Line 9 by starting with a name and address one could determine the telephone number(s) for that address. Regarding a storage unit, which stores at least one textual directory for loading into said recognition server, Shaffer et al teach on Column 21 Line 11 a directory assistance type of application. It is inherent that there must be a storage unit to store the directory information. It is also inherent that the directory information is textual information. Regarding a comparison unit for comparing said converted text form with a text entry in said at least one textual directory, Shaffer et al teach on item 612 Fig. 12 "compare LERG_LISY(K) to DPV_TELE #". The "DPV_TELE #" of Shaffer is the claimed "converted text form". The "LERG_LISY(K)" of Shaffer is the claimed "text entry". Regarding a textual directory unit for searching the electronic network to locate said contact data based said converted telephone number form of said telephone number, such that said selected contact data is inserted in the personal address book associated with the user, Shaffer et al teach on Column 21 Line 11 a directory assistance type of application. The directory of Shaffer is the claimed textual directory. Shaffer et al also teach on Column 14 Line 46 the captured telephone number and That updates the master table. The "update" of Shaffer is the claimed "inserted". The master table of Shaffer et al is the claimed "personal address book".

Regarding claim 7, Shaffer et al teach on item 213 Fig. 2 call processing center (the claimed application) and item 231 Fig. 2 remote database location (the claimed storage unit).

Regarding claim 12, Shaffer et al teach on item 205 Fig. 2 the calling into the system by the user.

Regarding claim 13, Shaffer et al teach on item 214 Fig. 2 VRU. It is inherent that the VRU must route the call to the system.

Regarding claim 15, Shaffer et al teach on ABSTRACT “the VRU to speak selected retrieved information to the caller”. The “speak” of Shaffer et al reads on the claimed “vocalized”. The “retrieved information” of Shaffer et al is the claimed “number”.

Regarding claim 17, Shaffer et al teach on item 214 Fig. 2 VRU. It is inherent that the textual directory must be loaded by the application (item 213 Fig. 2 of Shaffer et al) from the storage unit (item 231 Fig. 2 of Shaffer et al) to the recognition server in order to be presented to the user at item 202 Fig. 2 of Shaffer et al.

Regarding claim 19, Shaffer et al teach on ABSTRACT “needs to be verified by the caller. The “to be verified by the caller” is the claimed “user to approve”. It is inherent that the user must approve the name when verifying the retrieved information (telephone number of Shaffer et al; see Column 24 Line 10) that associates with the name.

Regarding claim 20, Shaffer et al teach on item 207 Fig. 202 computer. It is inherent that the user must approve textual data when the retrieved information is presented to the user on the computer.

Regarding claim 21, Shaffer et al teach on item 242 Fig. 2 Internet Server.

Regarding claim 23, Shaffer et al teach on Column 21 Line 11 a directory assistance type of application. It is inherent that there must be a directory server.

Regarding claim 24, it is inherent that the textual directory of Shaffer's system is a (computer) file.

Regarding claim 25, Shaffer et al teach on item 231 Fig. 2 database. It is inherent that the database of Shaffer et al is the claimed virtual memory source.

Regarding claim 26, Shaffer et al teach on item 231 Fig. 2 database. It is inherent that the database is the claimed management system.

Regarding claim 27, Shaffer et al teach on Column 21 Line determine the telephone number(s) for that address and the other individuals living at that address. It is inherent that the names of other individuals must be transferred by the system from the storage unit to ASR as a transcription.

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Regarding claim 28, Shaffer et al teach on Column 12 Line 28 connects the caller to the closest servicing location or the one selected by the caller. It is inherent that there must be at least two versions of matching name found to be selected by the user.

Regarding claims 30 and 41, Shaffer et al teach on Column 21 Line 11 other individuals. The other individuals of Shaffer et al is the claimed “contact’s name”. It is inherent that the contact name is a pronunciation when the VRU is used to present the retrieved information.

Regarding claims 31 and 37, Shaffer et al teach on Column 55 Line 46 capturing the first party identifier comprises capturing information from a voice recognition unit. The voice recognition unit of Shaffer et al is the claimed speech recognizer. The “first party identifier” of Shaffer et al is the claimed “recorded pronunciation”.

Regarding claims 32 and 42, Shaffer et al teach on Column 21 Line 10 determine the telephone number(s).

Regarding claims 33, 38, and 43, it is inherent that the name retrieved from the database (the claimed text name) must be processed by the speech recognizer (Column 55 Line 46) before it can be presented to the user at item 205 Fig. 2 of Shaffer et al.

Regarding claims 35 and 40, Shaffer et al teach on item 840 Fig. 18C “compare MT_REC_PHONE to DPU_LIST(1)_PHONE”. The “compare” of Shaffer et al is the claimed

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“verify”. The MT_REC_PHONE of Shaffer et al is the claimed “stored selected entry”. The “DPU_LIST(1)_PHONE” is the claimed “new contact”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al as applied to claim 1 above, and in view of S. Shaffer et al (US-PAT-NO: 5,950,165; herein referred as S_Shaffer). Shaffer et al failed to teach said application unit, said voice response unit, said recognition unit and said persistence storage unit are each hosted on different physical units. However, S_Shaffer et al teach on Fig. 1 application unit (item 102 Fig. 1 of S_Shaffer et al), voice response unit, recognition unit, and storage unit (item 106 Fig. 2 of S_Shaffer) are hosted on different physical units. It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have said application unit, said voice response unit, said recognition unit and said persistence storage unit are each hosted on different physical units as taught by S_Shaffer et al such that the modified system of Shaffer would be able to support the different physical units to the system users.

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Regarding claim 3, Shaffer et al failed to teach said application unit, said voice response unit, said recognition unit and said persistence storage unit are each hosted on the same physical units. However, S_Shaffer et al teach on Fig. 1 the said application unit, said voice response unit, said recognition unit and said persistence storage unit are each hosted on the same physical units (item 100 Fig. 1 of S_Shaffer). It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have said application unit, said voice response unit, said recognition unit and said persistence storage unit are each hosted on the same physical units as taught by S_Shaffer et al such that the modified system of Shaffer would be able to support the same physical units to the system users.

Regarding claim 4, Shaffer et al failed to teach two of the group comprising the said application unit, said voice response unit, said recognition unit and said persistence storage unit are hosted on different physical units. However, S_Shaffer et al teach on Fig. 1 the said application unit, said voice response unit, said recognition unit and said persistence storage unit are hosted on different physical units. it is inherent that the configurations of Fig.1 of S_Shaffer et al can be duplicated for a second group as described by Fig. 2A of the disclosed specification. The second group of S_Shaffer's system reads the claimed "two of the group". It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have two of the group comprising the said application unit, said voice response unit, said recognition unit and said persistence storage unit are hosted on different physical units as taught by S_Shaffer et al such that the modified system of Shaffer would be able to support the two of the group units to the system users.

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Regarding claim 5, Shaffer et al failed to teach three of the group comprising the said application unit, said voice response unit, said recognition unit and said persistence storage unit are hosted on different physical units. However, S_Shaffer et al teach on Fig. 1 the said application unit, said voice response unit, said recognition unit and said persistence storage unit are hosted on different physical units. It is inherent that the configurations of Fig.1 of S_Shaffer et al can be duplicated for a third group as described by Fig. 2A of the disclosed specification. The third group of S_Shaffer's system reads the claimed "two of the group". It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have three of the group comprising the said application unit, said voice response unit, said recognition unit and said persistence storage unit are hosted on different physical units as taught by S_Shaffer et al such that the modified system of Shaffer would be able to support the three of the group units to the system users.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al as applied to claim 1 above, and in view of Skladman et al (US-PAT-NO: 6,438,215). Shaffer et al failed to teach a firewall. However, Skladman et al teach on item 71 Fig. 1a firewall server. It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have a firewall as taught by Skladman et al such that the modified system of Shaffer would be able to support the firewall to the system users.

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9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al as applied to claim 1 above, and in view of Porter (US-PAT-NO: 6,282,270). Shaffer et al failed to teach telephone network is comprised of at least one element each from the group including E1 components, T1 components, voice over Internet protocol components and any other telephony connection. However, Porter teaches on Column 4 Line 43 T1 or E1 digital trunk. It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have telephone network is comprised of at least one element each from the group including E1 components, T1 components, voice over Internet protocol components and any other telephony connection as taught by Porter such that the modified system of Shaffer would be able to support the T1 and E1 to the system users.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al as applied to claim 1 above, and in view of Cheston et al (US-PAT-NO: 6,330,308).

Regarding claim 10, Shaffer et al failed to teach recording of the pronunciation comprises recording of the name and the number of the new contact. However, Cheston et al teach on Column 3 Line 63 the PED provides subscribers the ability to store names and numbers through audio signals which are preferably the subscriber's voice. The "store" of Cheston et al is the claimed "recording". It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have recording of the pronunciation comprises recording of the name and the number of the new contact as taught by Cheston et al such that the modified system of Shaffer would be able to support the recording of name and number to the system users.

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Regarding claim 11, the modified Shaffer's system in view of Cheston as stated in claim 10 above further failed to teach obtaining is from said recording of said pronunciation of said number. However, Cheston et al teach on Column 4 Line 3 the subscriber then may access his PED remotely from any DTMF telephone and have a requested name and number. The "access" of Cheston is the claimed "obtaining". It would have been obvious to one skilled at the time the invention was made to modify Shaffer and Cheston et al to have obtaining is from said recording of said pronunciation of said number as taught by Cheston et al such that the modified system of Shaffer and Cheston would be able to support the obtaining from said recording to the system users.

Regarding claim 16, Shaffer et al failed to teach the converting of said name and telephone number from speech to text form by said recognition server. However, Cheston et al teach on Column 3 Line 66 the PED subscriber accesses a voice response unit (VRU), and adds an entry by speaking the first four letters of the name to be stored followed by speaking the full name. It is inherent that the VRU must convert the name and telephone number from speech to text form. It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have the converting of said name and telephone number from speech to text form by said recognition server as taught by Cheston et al such that the modified system of Shaffer would be able to support the converting to the system users.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al as applied to claim 9 above, and in view of S. Shaffer et al (US-PAT-NO: 5,950,165). Shaffer et al

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failed to teach obtaining is from a Web-based device coupled to the system, wherein said coupling is to a recognition server via an application unit. However, S_Shaffer et al teach on item 502 Fig. 5 computer system. The computer system of S_Shaffer et al is the claimed Web-based device. S_Shaffer et al also teach on items 518 and 508 of Fig. 5 voice recognition and application. It is inherent that the VRU must convert the name and telephone number from speech to text form. It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have obtaining is from a Web-based device coupled to the system, wherein said coupling is to a recognition server via an application unit as taught by S_Shaffer et al such that the modified system of Shaffer would be able to support the Web-based device to the system users.

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al as applied to claim 9 above, and in view of Swan et al (US-PAT-NO: 6,351,222). Shaffer et al failed to teach training said ASR based on said associated textual data. However, Swan et al teach on Column 1 Line 45 train the voice recognition software. The voice recognition software of Swan et al is the claimed ASR. It is inherent that textual data must be generated (as described by applicant's specification line 10-14 page 7) for training. It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have the training said ASR based on said associated textual data as taught by Swan et al such that the modified system of Shaffer would be able to support the training to the system users.

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13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al as applied to claim 9 above, and in view of Dauerer et al (US-PAT-NO: 6,311,177). Shaffer et al failed to teach the source of said at least one textual directory is an intranet. However, Dauerer et al teach on Column 1 Line 56 ability to access directories or databases. The directories or databases of Dauerer is the claimed textual directory. Dauerer et al also teach on Column 2 Line 2 an intranet. It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have the source of said at least one textual directory is an intranet as taught by Dauerer et al such that the modified system of Shaffer would be able to support the intranet to the system users.

14. Claims 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al as applied to claim 33 above, and in view of Vysotsky et al (US-PAT-NO: 5,719,921). Shaffer et al failed to teach the selected entry is selected based on a match between the recorded pronunciation and the text name in the selected entry. However, Vysotsky et al teach on Column 10 Line 37 the customer is played a confirmation message the recording of the name associated in the databaseto identify the name John in the received speech. The “name ... in the received speech” of Vysotsky is the claimed “recorded pronunciation”. It is inherent that the “recording of the name associated in the database” must be the claimed text name when the name is stored in the database. It would have been obvious to one skilled at the time the invention was made to modify Shaffer et al to have the selected entry is selected based on a match between the recorded pronunciation and the text name in the selected entry as taught by Vysotsky et al such

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that the modified system of Shaffer would be able to support the match between recorded pronunciation and the text name to the system users.

Examiner's Interpretation

15. The examiner interprets Line 22 Page 12 of claim 1 to be “said contact data based on the converted text form of said new contact name, such thatwith the user”.

16. The examiner interprets Line 1 Page 17 of claim 32 to be “wherein said second identifying information ...”.

Conclusion

17. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Shi (US-PAT-NO: 6,438,524) teach method and apparatus for a voice controlled foreign language translation device.

18. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally

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be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

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Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
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